REMARKS

In the Final Office Action dated February 17, 2006, claims 1, 3-8, 10, 12-16 and 18-23 were rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over U.S. Patent No. US 6,285,398 ("Shinsky et al.") in view of U.S. Patent Application No. US 2004/0169767 A1 ("Norita et al."). In response, Applicant respectfully asserts that the Office Action has failed to establish a *prima facie* case of obviousness, as explained below. In particular, the Office Action has failed to point out a valid suggestion or motivation to modify the cited reference of Shinsky et al. with the teachings of Norita et al. to derive the claimed invention, as recited in the independent claims 1, 10 and 18. No claim amendments need to be entered since the rejected claims 1, 3-8, 10, 12-16 and 18-23 were not amended to place any of the rejected claims in better condition for appeal. In view of the following remarks, Applicant respectfully asserts that the pending claims 1, 3-8, 10, 12-16 and 18-23 are not obvious over Shinsky et al. in view of Norita et al., and requests that these claims be allowed.

A. Patentability of Independent Claims 1, 10 and 18

The Office Action has rejected the independent claims 1, 10 and 18 under 35 U.S.C. §103(a) as allegedly being unpatentable over Shinsky et al. in view of Norita et al. However, the Office Action has failed to establish a *prima facie* case of obviousness for these claims 1, 10 and 18. As such, Applicant respectfully requests that the independent claims 1, 10 and 18 be allowed.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The latest Office Action asserts on pages 6, 9 and 10 that "it would have been obvious for one skilled in the art to have been motivated to include the concept of adjusting the [current] settings of image capturing parameters according to a displayed image that is selected by a user as disclosed by Norita in the method of processing raw image data by setting image capturing parameters using a graphical user interface as disclosed by Shinsky." The alleged motivation for this modification is that "[d]oing so would provide a means for specifying an image having proper image capturing parameters while viewing a serially updated image in order to set the image capturing parameters (Norita: page 7, paragraph 135)."

The above assertion may provide a motivation to modify a digital still camera with the teachings of Norita et al. but not for a video camera, such as the video camera of Shinsky et al. The cited reference of Norita et al. discloses a digital camera that can sequentially capture a plurality of image signals corresponding to a plurality of exposure times with respect to a substantially same scene when the camera is switched to a multiple exposure mode. As described in paragraph [0119] of Norita et al., the captured images corresponding to a plurality of predetermined exposure times are sequentially displayed with increased exposure by a predetermined time interval with a lapse of time.

Such a process for capturing image signals using different exposure times for a substantially same scene DOES NOT make sense with respect to video cameras, such as the video camera of Shinsky et al. A video camera needs to capture tens of images per second to produce a smooth video. Thus, displaying captured images corresponding to a plurality of predetermined exposure times by a predetermined time interval with a lapse of time for user selection, as described in paragraph [0119] of Noritia et al., is not practical, if not impossible, using a video camera. Furthermore, in the same paragraph [0135] of Norita et al. where the alleged motivation can be found, Norita et al. states that the multiple exposure mode "is suitable for photo shooting requiring a long exposure time, e.g., for capturing a night view or celestial objects," which is obviously not appropriate using a video camera. Moreover, the cited reference of Norita et al. involves essentially displaying the same image with different exposure times, not displaying different images as is the case for the cited

reference of Shinsky et al. Thus, one of ordinary skill in the art would not have been motivated to modify the cited reference of Shinsky et al. with the teachings of Norita et al., as asserted by the Examiner. As such, Applicant respectfully asserts that the independent claims 1, 10 and 18 cannot be rendered obvious in view of Shinsky et al. and Norita et al., and requests that these claims be allowed.

B. Patentability of Dependent Claims 3-8, 12-16 and 19-23

Each of the dependent claims 3-8, 12-16 and 19-23 depends on one of the independent claims 1, 10 and 18.. As such, these dependent claims include all the limitations of their respective base claims. Therefore, Applicant submits that these dependent claims are allowable for at least the same reasons as their respective base claims.

Applicant respectfully requests reconsideration of the claims in view of the claim amendments and the remarks made herein. A notice of allowance is earnestly solicited.

Respectfully submitted,
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